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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,987	06/26/2003	Marc Christian Davis	DWP-P-1	5142
49578	7590	05/23/2008		
SIMMONS PATENTS P.O. BOX 1560 LENOIR, NC 28645				
EXAMINER				
GRAHAM, MARK S				
ART UNIT		PAPER NUMBER		
3711				
MAIL DATE		DELIVERY MODE		
05/23/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/606,987

Applicant(s)

DAVIS ET AL.

Examiner

Mark S. Graham

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-8 and 10-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-8 and 10-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bender in view of Smith. Note Bender at Col. 5, lines 16-19 specifically and the entire disclosure generally. Bender discloses the claimed device with the exception of the use of different first and second materials to obtain the different densities. However, such is a known technique in the art as taught by Smith. It would have been obvious to one of ordinary skill in the art to have used different materials in forming Bender's bat as well if it was desired to obtain particular densities in the different layers offered by different materials. With regard to the "sweet spot zone" or "center of mass" Bender's bat barrel will inherently have such a zone between two predefined points.

With regard to claim 13 requiring different lengths of the first and second portions note Bender at Col. 3, lines 40-48. The inner lamina portion extends the length of the bat and forms the handle and medial portion of the barrel while both outer lamina portions only extend the length of the barrel.

Claims 13-17 are rejected on the grounds of res judicata with regard to the 2/28/08 decision of the Board of Patent Appeals and Interferences in this application. A Board of Patent Appeals and Interferences decision in an application has res judicata effect and is the "law of the case" and is thus controlling in that application and any subsequent, related application. Therefore, a submission containing arguments without

either an amendment of the rejected claims or the submission of a showing of facts will not be effective to remove such rejection. No amendment or showing of facts has been provided with regard to claims 13-17.

Claims 1-3, 6, 7, 11, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bender in view of Smith and Cook. Note Bender at Col. 5, lines 16-19 specifically and the entire disclosure generally. Bender discloses the claimed device with the exception of the use of different first and second materials to obtain the different densities. However, such is a known technique in the art as taught by Smith. It would have been obvious to one of ordinary skill in the art to have used different materials in forming Bender's bat as well if it was desired to obtain particular densities in the different layers offered by different materials.

Bender in view of Smith obviates the claimed device for the reasons set forth above with the exception of the limitations pertaining to providing the different portions adjacent to one another along the length of the bat. However, as disclosed by Cook it is known in the art to vary the density of the bat along the longitudinal axis of the bat by creating separate sections adjacent to one another. It would have been obvious to one of ordinary skill in the art to have done the same with Bender's laminated sections to tailor the bat to a particular batter's needs. As stated by the Board of Patent Appeals and Interferences in the 2/28/08 decision each of the Bender, Smith, and Cook references are "directed to laminated bats which have increased performance or durability. Bender teaches increasing the durability, i.e., strength, of the bat by employing an inner laminated layer and outer laminated layers having a different

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density from the inner layer (Finding of Facts 1-4). Smith teaches using different types of wood for different portions/sections of the bat (Finding of Fact 9). Finally, Cook teaches using different laminated sections along the longitudinal axis of the bat (Finding of Fact 12). Therefore, it would have been within the skill of one of ordinary skill in the art to use different wood types as taught by Smith to alter the densities of the inner and outer layers of lamina not only along the vertical axis of the bat as taught by Bender, but also along the longitudinal axis as taught by Cook. Appellants have not provided any evidence that such a modification is outside the capabilities of one of ordinary skill in the art or that it produces an unexpected result."

Concerning claim 11, both Bender and Smith teach the use of Ash.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 1 above and further in view of Winterowd. Bender in view of Smith and Cook obviates the claimed device with the exception of the type of bonding agent used. However, as disclosed by Winterowd bonding agents such as that claimed are known in the woodworking art for bonding laminates. It would have been obvious to one of ordinary skill in the art to have used such as Bender's bonding agent to provide a secure bond.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 1 above and further in view of Burns. Bender in view of Smith and Cook obviates the claimed device with the exception of the sealant/protectant. However, as disclosed by Burns sealant/protectants such as that claimed are known for

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use on bats. It would have been obvious to one of ordinary skill in the art to have used such on Bender's bat to protect it.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable the art as applied to claim 1 above and further in view of You. Bender in view of Smith and Cook obviates the claimed device with the exception of the use of composites to form laminations. Bender uses wood for his laminations. However, as disclosed by You it is known in the art to use composites for such laminations as well. It would have been obvious to one of ordinary skill in the art to have used the same on Bender's bat to add strength to it.

Any inquiry concerning this communication should be directed to Mark S. Graham at telephone number 571-272-4410.

MSG
5/22/08

/Mark S. Graham/
Primary Examiner, Art Unit 37113